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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,645	11/16/1999	AVERY FONG	5244-0109-2	3214

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EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT PAPER NUMBER

2152

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/440,645

Applicant(s)

FONG ET AL.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,14-19,23-28 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-10,14-19,23-28 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/26/5 & 12/19/5
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. The amendment filed 1/3/2006 has been placed of record in the file.
2. Claims 25, 26, 28, and 35 have been amended.
3. The objections to the informalities in the claims are withdrawn in view of the amendment.
4. The rejection of claims 28 and 32-36 under 35 U.S.C. 112 is withdrawn in view of the amendment.
5. Claims 1, 5-10, 14-19, 23-28, and 32-36 are now pending.
6. The applicant's arguments with respect to claims 1, 5-10, 14-19, 23-28, and 32-36 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

### ***Information Disclosure Statement***

7. The IDS filed 10/26/2005 and the IDS filed 12/19/2005 have been considered.

### ***Response to Amendment***

8. Claims 25, 26, 28, and 35 have been amended to correct informalities and a lack of antecedent basis issue in the claims. The amendments do not prove a change in scope to the limitations of the claims.

***Claim Rejections***

9. Claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, and 35 remain rejected under 35 U.S.C. 102(e) as being anticipated by Miyachi (U.S. Patent Number 6,108,492) as presented in the previous rejection dated 10/3/2005.

10. Claims 5, 6, 9, 14, 15, 18, 23, 24, 27, 32, 33, and 36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Miyachi in view of Aikens et al. (U.S. Patent Number 5,414,494) as presented in the previous rejection dated 10/3/2005.

***Response to Arguments***

11. In the remarks, the applicant has argued:

- <Argument 1>

Miyachi does not disclose the features of the independent claims because he does not disclose “monitoring data of selecting of the plurality of operations of the operation panel by the user” and the like as recited in the independent claims.

12. In response to argument 1, it is maintained that Miyachi discloses the monitoring of the selecting of operations as claimed. The previous line citation, column 5, lines 57-65, clearly states that the multifunction peripheral’s processor monitors the condition of the multifunction peripheral and updates status information. These conditions are set forth in Table 1, as previously cited, and include a plurality of operations selected by a user at the operation panel. In support of the argument the applicant has stated that “Miyachi does not disclose or suggest any monitoring of buttons on an operation panel of an image forming device that a user selects” in paragraph 3 of page 9 of the remarks and again that “at no point does Miyachi disclose or

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suggest monitoring which button switches are selected by a user” in paragraph 1 of page 10 of the remarks. First, it is noted that the monitoring of buttons as argued by the applicant is not a limitation of the claims. The applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, even if the monitoring step was qualified specifically toward a monitoring of buttons, Miyachi teaches such monitoring as his system clearly monitors the user input (or operation panel) and takes action based on a user’s entry to the user input. See column 5, line 66 through column 6, line 3.

13. Although not a limitation of the claims, the applicant has pointed out that the “operations” in the present invention relate to such operations as “selection of a number of copies, copy conditions, paper size selection, etc.” Regarding this statement, it is noted that such copy conditions and paper size selections are taught by Miyachi. See Table 1, especially column 6, line 60 through column 7, line 35.

14. In further support of the argument the applicant has stated that “One objective of the present invention is to monitor such data so that a user’s usage of an operation panel can be evaluated, so that the setup, layout, control, etc. of an operation panel of an image forming device can be improved.” However, such evaluation and improvement steps are not limitations of the claims. The applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

15. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102 and 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus,

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claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

***Conclusion***

16. **THIS ACTION IS MADE FINAL.** The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

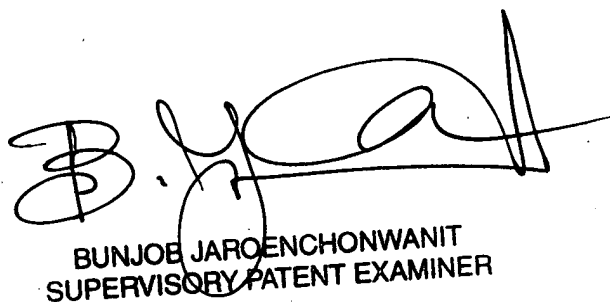
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski  
Patent Examiner  
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BUNJOE JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER